

Application Serial No. 09/874,055
Reply to final Office Action of May 4, 2007 and the
Advisory Action mailed August 21, 2007

SUPPORT FOR THE AMENDMENTS

Claims 3, 4, 6, 9, 10, and 12 were previously canceled.

Claims 1, 2, 5, 7, 8, and 13-18 have been amended.

Support for the amendment of Claims 1, 7, 8, and 13 is provided by the corresponding previously pending claims, the specification as filed, for example at page 15, line 21 to page 17, line 3, page 20, lines 7-12 and page 21, lines 12-20, and the Examples. The amendment of Claims 1, 2, 5, 6, and 14-18 find additional support on page 1, lines 5-11.

No new matter has been entered by the present amendment.

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REMARKS

Claims 1, 2, 5, 7, 8, 11, and 13-22 are pending in the present application.

Applicants note that the Examiner entered the response filed on August 2, 2007, “for purposes of appeal” (see paragraph 7 of the Advisory Action). Since no appeal is filed,

Applicants note that the claim amendment herein are made compared to the claims presented in the Amendment and Request for Reconsideration filed on January 26, 2007 (i.e., the last entered amendment). Accordingly, Applicants submit that the amendments herein are in compliance with 37 C.F.R. §1.121. Applicants wish to thank the Examiner for the indication that the amendments herein would overcome the rejection under 35 U.S.C. §112, second paragraph.

The rejection of Claims 1, 2, 5, 7, 8, 11, and 13-22 under 35 U.S.C. §112, first paragraph (written description), is obviated by amendment.

Consistent with the Examiner’s suggestion, Applicants have amended the claims to define the coating solution as a solvent solution wherein each of the recited components (e.g., formula 1, formula 3, and the hydrolysable organometallic compound) are dissolved in the solvent. Further, Applicants submit that this dissolution of the components in the solvent is implicitly supported by the specification by virtue of the characterization of the coating solution being a “solution”.

In the Advisory Action mailed August 21, 2007, the Examiner has taken the position that it remains unclear where in the specification support can be found for the limitation “wherein the compound represented by formula 1, the compound represented by formula 3, and the catalyst are dissolved in said solvent”. The Examiner’s basis is summarized as

follows: "It is not agreed that a solution implicitly discloses dissolution since art clearly recognizes colloidal solutions, which do not require dissolution per se."

Applicants disagree with the Examiner's position and note that a colloidal solution is not actually a solution, but rather is a suspension.¹ If Applicants intended for the coating solution to be a colloidal solution, this would have been specified.

Nonetheless, Applicants have amended the claims to delete the clause "wherein the compound represented by formula 1, the compound represented by formula 3, and the catalyst are dissolved in said solvent" to render moot this ground of rejection.

Applicants submit that the now deleted phrase was presented in the response filed on January 26, 2007. Applicants submit that the amendment to delete this phrase does not raise a new issue for search and/or consideration as this phrase was redundant with the "solvent solution" limitation. Further, Applicants submit that the distinction between Naito et al (previous basis of rejection) and the claimed invention is that Naito et al specifically disclose "a solvent-free cold-setting ternary organosiloxane composition" whereas the claimed coating solution is a "solvent solution comprising (a) a compound represented by formula 1... (b) a compound represented by formula 3... (c) a hydrolysable organometallic compound... and (d) *a solvent*." Therefore, even with the deletion of the objected to clause, Applicants submit that Naito et al teach away from the claimed invention and, thus, does not affect the patentability of the claimed invention.

Withdrawal of this ground of rejection is requested.

¹ As defined in Webster's Online Dictionary, a colloidal solution is a colloid that has a continuous liquid phase in which a solid is suspended in a liquid (see: <http://www.websters-online-dictionary.org/definition/colloidal+solution>).

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The rejection of Claims 1, 2, 5, 7, 8, 11, 13, and 14 under 35 U.S.C. §112, second paragraph, is obviated in part by amendment and traversed in part.

Applicants have amended the preamble of Claims 1, 2, 5, 6, and 14-18 based on page 1, lines 5-11 to more clearly and accurately define the material as suggested by the Examiner.

With respect to the Examiner's assertion that the claims contain improper Markush format, Applicants disagree. The claims contain a definition of the R groups in proper Markush form. For example, the definition of R₉ and R₁₁ are in Claim 1 is "R₉ and R₁₁ are independently selected from the group consisting of a hydrogen, an alkyl group having 1-10 carbon atoms **and** an alkenyl group having 1-10 carbon atoms" and R₁₀ and R₁₂ are defined as "R₁₀ and R₁₂ each is independently selected from the group consisting of an alkyl group having 1-10 carbon atoms, an alkenyl group having 1-10 carbon atoms, a phenyl group, **and** a phenyl group having an epoxy group or a glycidyl group". The remaining independent claims contain the comparable language. Thus, contrary to the Examiner's assertion, the last species set forth in the Markush groups uses the term "and" not "or".

In view of the foregoing, Applicants request withdrawal of this ground of rejection.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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